

REMARKS

Summary of Claim Status

Claims 1-5, 7-16, and 18-21 are pending in the present application after entry of the present amendment, and are rejected for the reasons discussed below. Applicants respectfully request favorable reconsideration of the claims and withdrawal of the pending rejections in view of the present amendment and in light of the following discussion.

Rejection Under 35 U.S.C. § 112

Claim 1 is rejected under 35 U.S.C. § 112, the Examiner stating that there is insufficient antecedent basis for the limitation "the step of packaging" in Claim 1. Applicants have amended Claim 1 to correct this minor clerical error. Claim 1 now recites "the step of providing," and Applicants believe the rejection has been overcome. Therefore, Applicants respectfully request withdrawal of the rejection.

Rejections Under 35 U.S.C. § 102

Claims 12-15 and 18-20 are rejected under 35 U.S.C. § 102(a) as being anticipated by Mucciolo et al., "PowerPoint 2000" published in May 1999 ("Mucciolo"). Applicants respectfully traverse this rejection with respect to all claims.

With respect to Claim 12, the Examiner stated:

Mucciolo teaches that PowerPoint provides a user with an option of customizing the size of slide, size of paper, orientation, and number of slides per page. It is also easily realized by one of ordinary skill in the PowerPoint art that by adjusting the size of the slide, the image or presentation printed on a paper is adjusted accordingly. On the other hand, the size of presentation material is reduced/enlarged in

accordance with the 'width' and 'height' defined by a user in fig. 8.2. Therefore, 'width' and 'height' can be reduced to the size of a business card, which has a dimension of 2 X 3½.

Office Action at page 4, ¶5.

Applicants respectfully disagree with the statement that Claim 12 "is clearly anticipated by Mucciolo." Id. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP 2131, citing Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Applicants submit that Mucciolo does not teach that "the reformatting mechanism is further configured to reformat the presentation as a miniature presentation having the size of a business card" as recited in Claim 12, and thus at least this element is not found in Mucciolo.

Figure 8.2 of Mucciolo merely shows a page setup dialog box which has a "Letter Paper (8.5x11 in)" option in a drop-down list selected corresponding to a width of 10 inches and a height of 7.5 inches (e.g., to allow for a 0.5 inch margin on each side). Nowhere does Mucciolo teach or suggest that the page may be setup for a size of a business card. In fact, page 179 of Mucciolo discloses that the standard pre-defined paper sizes available in the drop-down list are Onscreen Show, Letter Paper, A4 Paper (international standard), 35mm Slides, Overhead, and Banner.

While Applicants concede that it may have been technically feasible to set a custom slide size that corresponds to a business card size (or any other arbitrary size) nothing in Mucciolo discloses a business card size, or suggests that such a size may be useful or desirable. Nowhere in the portion of Mucciolo provided by the Examiner is a business card size even mentioned. In contrast, the specification notes that one advantage to a presentation

having the size of a business card is that an audience member is more likely to retain the presentation and less likely to discard the materials. (See, e.g., specification at page 9, lines 24-34). In fact, Applicants submit that Mucciolo teaches away from a business card size. Mucciolo describes the Microsoft PowerPoint 2000 software, which is presentation software. PowerPoint is designed to create slides for a presentation that is typically displayed on a projection system to a large audience. PowerPoint also provides options for creating handouts for the audience to follow along with the presentation. The goals of the PowerPoint software are therefore contrary to a miniature presentation having the size of a business card, since such a small size would not be conducive to presenting to a large audience or making it easy for an audience to follow along.

As Mucciolo further describes, PowerPoint includes Slides, Handouts, Note Pages, and Outline View as options for printing. (Mucciolo at page 181). As noted in the specification, a disadvantage of such formats is that the audience is likely to discard these materials after the end of the presentation. (See, e.g., specification at page 1, line 32 to page 2, line 6). However, by reformatting the presentation as a miniature presentation having the size of a business card, audience members are less likely to discard such materials.

Therefore, for at least the reasons set forth above, Applicants submit that Claim 12 is not clearly anticipated by Mucciolo, and Applicants respectfully request allowance of Claim 12.

Claims 13-15 depend, either directly or indirectly, from Claim 12, and thus include all of the limitations of Claim 12. Applicants believe Claim 12 is allowable for the reasons set forth above. Therefore, for at least the same

reasons, Applicants believe Claims 13-15 are also allowable, and respectfully request allowance of such claims.

Claim 18 recites "wherein the miniature version of the presentation materials has the size of a business card." As set forth in the remarks above, Mucciolo does not disclose or even suggest a miniature presentation having the size of a business card. Therefore, Applicants believe Claim 18 is allowable over the cited reference. Claim 19 depends from Claim 18, and is therefore also believed to be allowable for at least the same reasons. Applicants respectfully request allowance of Claims 18 and 19.

Claim 20 recites "wherein the miniature version of the presentation has the size of a business card." As set forth in the remarks above, Mucciolo does not disclose or even suggest a miniature presentation having the size of a business card. Therefore, Applicants believe Claim 20 is allowable over the cited reference, and respectfully request allowance of Claim 20.

#### Rejections Under 35 U.S.C. § 103

Claims 1-3, 5, 7, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mucciolo in view of Skarbo et al., U.S. Patent No. 5,852,807 ("Skarbo"). Applicants respectfully traverse this rejection.

With respect to Claim 1, Applicants first submit that Mucciolo does not teach "the step of creating a miniature printed version comprises creating a miniature printed version of the presentation materials in the size of a marketing product" as recited in Claim 1. As stated above, while Mucciolo discloses that the size of the slide may be adjusted in PowerPoint, Mucciolo does not disclose that the size is a size of a marketing product. Nothing in Skarbo

remedies this deficiency of Mucciolo. In fact, nowhere in either Mucciolo or Skarbo is a marketing product or its equivalent even mentioned.

Furthermore, the Examiner conceded that "Mucciolo does not teach explicitly a step of packaging the miniature printed version of the presentation materials with a marketing product." (Emphasis omitted). The Examiner went on to state that Skarbo teaches a step of packaging the presentation materials with a marketing product, citing "BIZCARD having all of presentation materials in fig. 3b." Applicants respectfully disagree with this characterization of the reference, and respectfully submit that Mucciolo, in any combination with Skarbo, does not teach or suggest "the step of packaging comprises packaging the miniature printed version of the presentation materials with a marketing product" as recited in Claim 1.

Skarbo describes an electronic business card, called a BIZCARD, that may be used for teleconferences where it would be impossible to circulate a physical business card. Skarbo notes that in traditional face-to-face meetings, participants often exchange physical business cards having information about each of the participants. This exchange is not possible in a PC conference, so Skarbo proposes an electronic "business card" that is merely a visual presentation of information commonly found on physical business cards wherein the information is stored internally in data structures. (See, generally, Skarbo at Background of the Invention, col. 1, lines 19-59, and Skarbo at Summary of the Invention, col. 2, line 62 to col. 3, line 10). In summary, Skarbo only describes an electronic business card intended to replace or substitute for physical printed business cards.

Moreover, Figure 3b of Skarbo merely illustrates the internal data structures used to store business card information. In particular, the information consists of information typically found on a business card, such as name, title, company name, and contact information. In contrast to Claim 1, the information does not include any presentation materials. That is, Skarbo does not teach or even suggest packaging a miniature printed version of the presentation materials with a marketing product. In fact, since Skarbo deals exclusively with problems associated with teleconferencing and only describes a purely electronic business card, there is clearly no teaching of any "miniature printed version." Skarbo teaches away from a printed version, and advocates using only electronic data.

Therefore, Applicants believe that it would not have been obvious to one of ordinary skill in the art to combine the electronic business card taught by Skarbo with Mucciolo, and that it would be impossible to combine Skarbo and Mucciolo in a manner that would teach or suggest the invention of Claim 1. For at least the reasons presented above, Applicants believe Claim 1 is allowable, and allowance of Claim 1 is respectfully requested.

Claims 2, 3, 5, 7, and 11 depend from Claim 1, and thus include all of the limitations of Claim 1. Applicants believe Claim 1 is allowable for the reasons set forth above. Therefore, for at least the same reasons, Applicants believe Claims 2, 3, 5, 7, and 11 are also allowable, and respectfully request allowance of such claims.

Claims 4 and 8-10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mucciolo and Skarbo, in further view of Pirrello, U.S. Patent No. 5,685,568 ("Pirrello"). Claims 4 and 8-10 depend indirectly from Claim 1, and thus

include all of the limitations of Claim 1. Applicants believe Claim 1 is allowable for the reasons set forth above. Nothing in Pirrello overcomes the deficiencies of Mucciolo and Skarbo, and thus Mucciolo, in any combination with Skarbo and Pirrello, does not disclose or even suggest the invention of Claims 4 and 8-10. Pirrello merely describes an apparatus for holding cards. Therefore, for at least the same reasons set forth above with respect to Claim 1, Applicants believe Claims 4 and 8-10 are also allowable, and respectfully request allowance of such claims.

Claim 16 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Mucciolo in view of Stephan, U.S. Patent No. 6,192,117 ("Stephan"). Claim 16 depends indirectly from Claim 12, and thus includes all of the limitations of Claim 12. Applicants believe Claim 12 is allowable for the reasons set forth above. Nothing in Stephan overcomes the deficiencies of Mucciolo, and thus Mucciolo, in any combination with Stephan, does not disclose or even suggest the invention of Claim 16. Stephan merely describes a telephone calling card. Therefore, for at least the same reasons set forth above with respect to Claim 12, Applicants believe Claim 16 is also allowable, and respectfully request allowance of Claim 16.

Claim 21 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Stephan in view of Mucciolo. With respect to Claim 21, the Examiner stated that "Stephan disclose a business card comprising: . . . said second face has printed thereon a presentation (phone card in fig. 2)." Applicants respectfully disagree with this characterization of the reference and traverse this rejection.

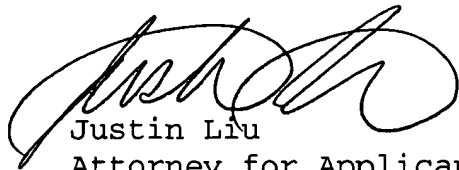
As set forth in Stephan, Fig. 2 depicts a card having calling card information. In particular, the card of Fig. 2

includes an 800 LD number, a PIN, a date and time when the card can be used, and the authorized LD duration. (Stephan at col. 4, line 63 to col. 5, line 6). That is, the reverse side of the card disclosed in Stephan provides all of the information needed to place a calling card long distance telephone call. There is no mention of any presentation, much less a miniature version of a presentation presented by a person corresponding to the identification information on the first face, as recited by Claim 21. Nothing in Mucciolo overcomes this deficiency of Stephan. Therefore, Applicants believe Claim 21 is allowable over Stephan and Mucciolo, and thus request allowance of Claim 21.

#### Conclusion

No new matter has been introduced by any of the above amendments. In light of the above amendments and remarks, Applicants believe that Claims 1-5, 7-16, and 18-21 are in condition for allowance, and allowance of the application is therefore requested. If action other than allowance is contemplated by the Examiner, the Examiner is respectfully requested to telephone Applicants' attorney, Justin Liu, at 408-879-4641.

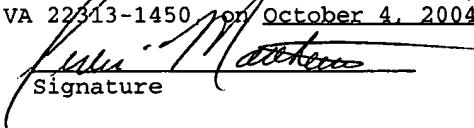
Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Patents, P.O. BOX 1450, Alexandria, VA 22313-1450, on October 4, 2004.

Julie Matthews  
Name



Signature